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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,147	12/07/2004	Koichi Kinoshita	TOS-159-USA-PCT	1181

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TOWNSEND & BANTA  
c/o PORTFOLIO IP  
PO BOX 52050  
MINNEAPOLIS, MN 55402

EXAMINER
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OGDEN JR, NECHOLUS

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/517,147

Applicant(s)

KINOSHITA ET AL.

Examiner

Necholus Ogden

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 8-2-2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10,11,13,14 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,11,13,14 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1 and 8 each comprise parenthesis around the description according to formula I, however, the use of parenthesis in the claim is considered indefinite because the limitations included within the parenthesis may or may not be considered a claimed limitation. Corrections are required.
5. Claim 8 states, in component (c), is a "higher" alcohol, wherein the term "higher" is not adequately defined where one of ordinary skill in the art would be able to determine the metes or bounds of the invention.

Claims 1-6, 8, 10-11, 13-14, 19-28 rejected under 35 U.S.C. 103(a) as being obvious over JP (58-101197) in view of JP (2001233743) are withdrawn.

Claims 1-6, 8, 10-11, 13-14, 19-28 rejected under 35 U.S.C. 103(a) as being obvious over JP (1-178596) in view of JP (2001233743) are withdrawn.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 1-6, 8, 10-11, 13-14, 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (1-178596) in view of Guillou et al (2003/0165455).

JP '596 disclose a cleaning composition comprising alkyloyl alkyl taurates of formula I; polyethylene glycol; nonionic surfactants of formula II and polyoxyalkyl ether; additional surfactants; and citric acid or lactic acid. (abstract). Note, see example 5.

JP '596 teaches each of the claimed components except applicant's N-methyl taurine compound.

Guillou et al disclose a foaming surfactant composition for cleansing hair (0002) comprising anionic surfactants such as taurates, methyl-taurates and their salts such as potassium and sodium (0048).

It would have been obvious to one of ordinary skill in the art to include the additional N-methyl taurate compound of Guillou et al to the compositions of JP '596 because the references are for use in personal cleansing compositions and taurates are well known in the art for their foaming properties and as surface active agents. Therefore, one of ordinary skill would have been motivated to include the component because only an additive or beneficial results would have been obtained in the absence of unexpected results since the compositions of JP '596 employ surfactants and Guillou et al suggests the equivalence of many surfactants. Accordingly, it is held that the claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention because according to the Supreme Court, the teaching, suggestion, or motivation test (TSM test) is one of a number of valid rationales that could be used to determine obviousness. It is not the only rationale that may be relied upon to support a

conclusion of obviousness. (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

Claims 1-6, 8, 10-11, 13-14, 19-28 are rejected under 35 U.S.C. 103(a) as being obvious over JP (58-101197) in view of Guillou et al (2003/0165455).

JP '197 discloses detergent composition comprising taurine type surfactants of formula III; citric acid; polyethylene glycols; additional surfactants and polyoxyethylene alkyl ethers (abstract). Note, see example 6.

Guillou et al disclose a foaming surfactant composition for cleansing hair (0002) comprising anionic surfactants such as taurates, methyl-taurates and their salts such as potassium and sodium (0048).

It would have been obvious to one of ordinary skill in the art to include the additional N-methyl taurate compound of Guillou et al to the compositions of JP '197 because the references are for use in personal cleansing compositions and taurates are well known in the art for their foaming properties and as surface active agents. Therefore, one of ordinary skill would have been motivated to include the component because only an additive or beneficial results would have been obtained in the absence of unexpected results since the compositions of JP '197 employ surfactants and Guillou et al suggests the equivalence of many surfactants. Accordingly, it is held that the claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention because according to the Supreme Court, the teaching, suggestion, or motivation test (TSM test) is one of a number of valid rationales that could be used to

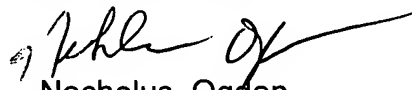
determine obviousness. It is not the only rationale that may be relied upon to support a conclusion of obviousness. (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Necholus Ogden  
Primary Examiner  
Art Unit 1796

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10/517,147  
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